

# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/775,561	02/10/2004	David Harwood	10557/291180	10557/291180 1433	
30559	7590 06/08/	06	EXAMINER		
CHIEF PATENT COUNSEL			MATTHEWS, WILLIAM H		
SMITH & N. 1450 BROOI	EPHEW, INC. KS ROAD		ART UNIT	PAPER NUMBER	
MEMPHIS,	MEMPHIS, TN 38116				

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

				P			
		Application No.	Applicant(s)				
		10/775,561	HARWOOD ET AL.				
	Office Action Summary	Examiner	Art Unit	_			
		William H. Matthews (Howie)	3738				
Period fo	The MAILING DATE of this communication app or Reply	ears on the cover sheet with the c	orrespondence address				
WHIC - Exter after - If NO - Failu Any r	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DATES of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. In period for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing and patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status							
1)  🏹	Responsive to communication(s) filed on <u>15 M</u>	arch 2006.					
•	This action is <b>FINAL</b> . 2b) This action is non-final.						
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
,—	closed in accordance with the practice under E						
Dispositi	on of Claims						
_	Claim(s) 1-35 is/are pending in the application.						
•	4a) Of the above claim(s) is/are withdrawn from consideration.						
	Claim(s) <u>10-31 and 33-35</u> is/are allowed.						
· —	☐ Claim(s) 1-9 and 32 is/are rejected.						
·	Claim(s) is/are objected to.						
8)	Claim(s) are subject to restriction and/o	r election requirement.					
Applicati	on Papers						
	The specification is objected to by the Examine	r					
•	The drawing(s) filed on is/are: a) _ acce		Examiner.				
10/	Applicant may not request that any objection to the						
	Replacement drawing sheet(s) including the correct	-					
11)	The oath or declaration is objected to by the Ex						
Priority ι	under 35 U.S.C. § 119						
12)	Acknowledgment is made of a claim for foreign  ☐ All b) ☐ Some * c) ☐ None of:		)-(d) or (f).				
	1. Certified copies of the priority document		ian Ma				
	<ul><li>2. Certified copies of the priority document</li><li>3. Copies of the certified copies of the priority</li></ul>						
	3. Copies of the certified copies of the prior application from the International Bureau	·	ed in this National Stage				
* 9	See the attached detailed Office action for a list		ed.				
		or the continue copies not receive	•				
Attachmen	ot(s)	_					
	ce of References Cited (PTO-892)	4) Interview Summary Paper No(s)/Mail D					
3) Infor	ce of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) er No(s)/Mail Date	F	ate Patent Application (PTO-152)				

Application/Control Number: 10/775,561 Page 2

Art Unit: 3738

### Response to Arguments

1. Applicant's arguments filed 3-15-06 have been fully considered but they are not persuasive.

- 2. Regarding claims 6, 17 and 32 Applicant contends "the incision guide consists of a transparent portion of a surface of the incision locator" is supported by the figures. Examiner disagrees because the figures and specification only disclose an opening, which does not include the surface of the incision locator. Therefore the limitation implies a clear element rather than an opening.
- 3. Regarding claims 1-9 as rejected in view of Graser, Applicant contends the Graser is used for different orthopedic surgery so therefore does not anticipate the current claims. Examiner disagrees because claims 1-9 are directed to a device "adapted to" or "configured for" use in hip replacement surgery. The structure disclosed by Graser anticipates the structure of claims 1-9, and because of the angled wings and incision guides is capable of meeting the intended use recitations of claims 1-9.

## Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 6, 17, and 32 recite "incision guides consists of a transparent portion" which is not disclosed in the specification.

Application/Control Number: 10/775,561 Page 3

Art Unit: 3738

#### Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6,17,32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 6, 17, and 32 recite "incision guides consists of a transparent portion of a surface" which is not disclosed in the specification. The specification only provides support for the incision guide comprising an opening.

#### Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 5. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Graser US PN 5,843,085.

Graser discloses a guide in figure 1A that could be used as an incision locator having two wings with transverse slots (20,30) that could be used as incision guides, or

marking openings, and could be oriented along the femoral axis and configured to indicate the proper incision location of a hip replacement surgery. The transverse slots (20, 30) allow for visualization through one side of the guide to the other and are therefore transparent. The guide of Graser may be employed in various slot sizes, lengths (including 10cm) and diameters to be used for both smaller and larger bones of the human body, additionally, the angle (90) between the "wings" may be any angle between 1-180° (including 30°), (column 12, lines 26-36). The integral geometric shape of the guide in figure 1A is a triangle and allows for incisions to be made through any of the slots in the many embodiments.

#### Allowable Subject Matter

6. Claims 10-31,33-35 are allowed.

#### Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Application/Control Number: 10/775,561 Page 5

Art Unit: 3738

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas Examiner

William H. Matthews (Howie)

AU 3738